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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,119	06/22/2000	GERHARD BENNER	BEIERSDORF62	7901

7590 05/15/2003

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/15/2003

JO

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/582,119	BENNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 February 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 15-22 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |                                                                                              |                                                                             |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

Claims 15-22 are pending. The Amendment filed 2/26/03, Paper No. 19, cancelled the previously pending claims, added claims 15-22, and inserted a sentence as the first paragraph of the specification.

Applicant's arguments with respect to claims 15-22 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/03 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-16, 18-20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann (4,735,742) in view of Pottier (Fr 1,437,366).

The instant invention is directed toward an oil-in-water emulsion comprising glycerol or tocopheryl acetate, glycerol stearate citrate, and cetylstearyl alcohol.

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Ansmann teach oil-in-water emulsions comprising a primary emulsifier, a palmitic acid soap and stearic acid soap. Exemplified is an oil-in-water emulsion comprising cetylstearyl alcohol and glycerol. See abstract; Col. 7,m lines 26-35. The reference does not teach glycerol stearate citrate.

Pottier teaches cosmetic soaps. Soap is taught as promoting epidermal dryness, roughness, cracking and other detrimental effects. Exemplified is an oil-in-water emulsion comprising glycerol stearate citrate, wherein the glycerol stearate citrate suppresses the harmful influence of the soap. Palmitic acid, stearic acid, and glycerol stearate citrate are taught as interchangeable emulsifiers. See pg. 3-5 and pg. 12.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the glycerol stearate citrate taught by Pottier for the palmitic acid and stearic acid of Ansmann because of the expectation of achieving similar emulsifying effects and of achieving a cosmetic that suppresses the harmful influence of fatty acid soaps, such as drying and cracking the skin.

While a 1:1 ratio of glycerol stearate citrate to cetylstearyl alcohol is not explicitly stated, it is respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 19-22 are directed to a method of reducing the stickiness of an o/w emulsion comprising glycerol or tocopheryl comprising adding glycerol stearate citrate and cetylstearyl alcohol to the emulsion. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its

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properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches compositions containing the same components as instantly claimed, which must possess the property of reducing stickiness as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann in view of Pottier as applied to claims 15-16, 18-20, 22 above, and further in view of Wallat et al. (DE 3,820,693).

Ansmann and Pottier are applied as discussed above. The references do not teach tocopheryl acetate.

Wallat et al. teach tocopheryl acetate as a physiological agent that can be added to cosmetic and pharmaceutical preparations, particularly for the treatment of aging skin. See pages 2-3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add tocopheryl acetate, as taught by Wallat et al., to the composition of the combined references because of the expectation of achieving a product that treats skin aging.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
March 26, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
4/2/03